



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ihor Lys, et al.
 Serial No.: 09/213,581
 Confirm. No.: 6707
 Filed: December 17, 1998
 For: KINETIC ILLUMINATION SYSTEMS AND METHODS
 Examiner: Lee, Wilson
 Art Unit: 2821

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the 16th day of July, 2003.

Stephanie Godino

Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir:

Transmitted herewith are the following documents:

- ☒ Response to Restriction Requirement/Election
- ☒ Return Receipt Postcard

If the enclosed papers are considered incomplete, the Mail Room and/or the Application Branch are respectfully requested to contact the undersigned at (617) 395-7000.

A check is not enclosed. If a fee is required, the Commissioner is hereby authorized to charge Deposit Account No. 50/2762. A duplicate of this sheet is enclosed.

Respectfully submitted,
 Ihor Lys, et al., Applicants

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Attorney Docket No.: C110470049
 Date: July 16, 2003
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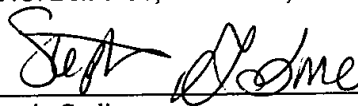
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RESPONSE TO RESTRICTION REQUIREMENT/ELECTION

Sir/Madam:

In response to the Office Action mailed June 17, 2003 in the above-identified application, Applicants hereby elect the invention of Group I, namely, claims 1, 2, 8-26, 58-60 and 68-76. The Office Action identified (see page 4) claims 1, 2, 17, 18, 22-26, 68 and 74-76 as being generic to a plurality of patentably distinct species. While Applicants do not necessarily agree with the Examiner's characterization of any of the indicated species, Applicants elect Species 3, namely claims 15, 16, 19-21 and 72, for further prosecution. The Examiner has indicated that the Species 3 claims allegedly define "an information board" as illustrated in Figure 49. Applicants respectfully point out, however, that at least claims 19-21 of this species are not limited to, nor necessarily related to, an "information board," as alleged by the Examiner.

In sum, Applicants elect for further prosecution the following claims of Group 1, Species 3: claims 1, 2, 15-26, 68, 72 and 74-76. The claims of the remaining species indicated by the Examiner, namely claims 8-13 and 71 (Species 1), claim 14 (Species 2), claim 69 (Species 4) and claim 70 (Species 5) are entitled to consideration upon the allowance of their respective Group 1 base claims, pursuant to MPEP §809.04.

The foregoing election is made with traverse, for a number of reasons.

First, of the Group 1 claims, the Examiner has failed to indicate whether claims 58-60 and 73 are generic, or fall into one of the identified species or another yet unidentified species. Accordingly, the Examiner has failed to meet his burden, pursuant to MPEP §809.02(a)(A) and (B), to identify generic claims and clearly identify each of the disclosed species to which claims are restricted. As a result, the Applicants have no way of knowing how the claims 58-60 and 73 may be pursued for further prosecution. For at least this reason, the restriction requirement is improper and should be withdrawn.

Second, and perhaps most significantly, the Examiner has already demonstrated that search and examination of all of the claims pending in the present application can be made without serious burden, as **the subject matter presently claimed already has been examined by the Examiner in five previous Office Actions** (Office Actions dated April 12, 2000, October 4, 2000, March 28, 2001, October 10, 2001 and June 5, 2002). Specifically, all of the subject matter to which each of the presently restricted groups is drawn was covered in the fifty claims originally filed with the application (e.g., retail display, at least claim 1; non-opaque container, at least claim 41; vending machine, at least claim 42; article of clothing, at least claim 45; stencil or gobo, at least claim 37). While some minor amendments to the claims have been made during prosecution, the overall subject matter covered by the claims essentially has not changed.

Hence, by the Examiner's own prior actions (i.e., five substantive Office Actions to date), the Examiner has conceded that search and examination of these claims can be made without a serious burden. According to MPEP §803, "if the search and examination of an entire application can be made without serious burden, the examiner **must** examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). For at least this additional reason, the restriction requirement is improper and should be withdrawn.

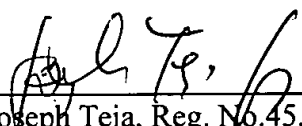
Applicants also wish to note that they do not necessarily concur with at least some of the Examiner's comments regarding the subject matter allegedly covered by the claim groupings. For example, on page 3 of the Office Action, in connection with inventions I, V and VI, the Examiner states that "Invention V illuminates object [sic] directly that is different from the indirect illumination as required by Inventions I and VI." Applicants respectfully disagree with this statement. There is no requirement in any of the claims of these groups regarding an object being illuminated directly or indirectly. Rather, claim 1 of Group I recites that an LED system is placed to project light onto a retail display such that an observer sees at least some of the light substantially indirectly via the retail display, and not directly from the LED system. Again, this recitation says nothing in particular about how the retail display itself is illuminated.

In conclusion, Applicants have distinctly and specifically pointed out what are respectfully believed to be errors in this Restriction Requirement, and hence traverse this requirement. In doing so, Applicants retain the right to petition from the requirement under 37 C.F.R. §1.144.

Applicants respectfully request the Examiner to reconsider and withdraw the Restriction Requirement and proceed with prosecution on the merits of all of the presently pending claims.

Respectfully submitted,

Ihor Lys, et al., Applicants

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